

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-7, 9-10 and 25-27 are pending, with Claims 1, 3, 9 and 25 amended, Claim 27 added and Claims 8 and 11-24 canceled by the present amendment.

In the Official Action, Claims 1-10, 17, and 19-24 were rejected under 35 U.S.C. § 112, first paragraph; Claims 1-19 and 21-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ohkado (U.S. Patent No. 6,542,165); and Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohkado in view of Official Notice.

Applicants acknowledge with appreciation the telephone discussion between the Examiner and Applicant's representative on August 27, 2007. During the telephone discussion, the outstanding rejection under 35 U.S.C. § 112, first paragraph was discussed. Applicants' representative noted that while the word "transparent" is not explicitly recited in the specification, the concept of a transparent overlay is disclosed in the specification (see e.g. page 6, lines 4-10). The Examiner suggested replacing the word "transparent" with varying language to describe Applicants' claimed overlay.

Applicants acknowledge the telephone discussion between the Examiner and Applicant's representative on September 13, 2007. During the telephone discussion, the present amendment was discussed relative to the outstanding rejection under 35 U.S.C. § 112, first paragraph. The Examiner indicated that reciting the pixel replacement described on page 7 of Applicants' specification would overcome the outstanding rejection under 35 U.S.C. § 112, first paragraph.

Claims 1 and 25 are amended to recite Applicants' claimed "overlay" with varying language. That is, Claims 1, 25 and 27 recite, *inter alia*, a "a primary workstation overlay displayed on top of said displayed contents of said first file by replacing a pixel of said

displayed contents of the first file displayed on the primary workstation with a pixel of the primary workstation overlay so that the primary workstation overlay and a portion of the displayed contents of said first file are simultaneously viewable on said primary workstation.” Support for this varying language is found in Applicants’ originally specification.<sup>1</sup> Further details about Applicants’ claimed simultaneously viewable overlay and first file are found in Applicants’ specification.

Claims 1 and 25 are amended to clarify that the claimed invention is directed to a video teleconferencing method and/or system. Support for this amendment is found in Applicant’s originally filed specification.<sup>2</sup> No new matter is added.

Briefly recapitulating, amended Claim 1 is directed to:

A method of displaying an electronic file to a primary user having a primary workstation coupled to a videoconferencing system via a computer network, and displaying said electronic file to at least one secondary viewer via a secondary workstation connected to said computer network at a remote location, comprising:

conducting a videoconference between said primary and secondary workstations;

displaying contents of a first file on said primary workstation while conducting said videoconference;

displaying said contents of said first file on the secondary workstation during said videoconference;

accessing a second file comprising information relating to said first file;

displaying first and second contents of said second file on said primary workstation as a primary workstation overlay displayed on top of said displayed contents of said first file by replacing a pixel of said displayed contents of said first file displayed on said primary workstation with a pixel of the primary workstation overlay so that the primary workstation overlay and a portion of the displayed contents of said first file are simultaneously viewable on said primary workstation; and

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<sup>1</sup> Specification, page 7, lines 20-27.

<sup>2</sup> Specification, page 5, lines 8-14.

displaying said second contents of said second file on said secondary workstation as a secondary workstation overlay while not displaying said first contents of said second file on said secondary workstation, said secondary workstation overlay displayed on top of said displayed contents of said first file by replacing a pixel of said displayed contents of said first file displayed on said secondary workstation with a pixel of the secondary workstation overlay so that the secondary workstation overlay and a portion of the displayed contents of said first file are simultaneously viewable on said secondary workstation.

Claims 25 and 27 are directed to a corresponding computer program product and system.

Ohkado describes a method and device where an application window is designated by an operator and a transparent child window of the application window is generated. Ohkado describes that the device may be used in collaborating with another terminal located in a remote location. One mode of such collaboration includes starting a window of an application to be collaborated in a corresponding transparent window in the collaborating systems, and transmitting only data such as a figure drawn on the transparent window to the collaborating system to develop a drawing on the transparent window of the collaborating system (see e.g. Figure 5). Ohkado also describes running an application to be collaborated only on one of the systems and transmitting the image to the other terminal (Figure 6).

As shown in Figure 3 of Ohkado, when the operator on the main station inputs an address of the destination of a connection, a session with the other computer is established. After the connection is established, a desired application can be selected from the list of applications which are candidates for collaboration via a pull down window 363.<sup>3</sup> Annotation data drawn on a transparent window is transmitted to the other system with the drawings reproduced on the local transparent window. The transmission may be either one-way or two-way. In one embodiment, the annotation is selectively inhibited in the other station so that only the main station can perform the annotation. The annotation is completed in either station, with only the figure data transferred to the other station. The figure data is

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<sup>3</sup> Ohkado column 12, lines 18-50.

dated for defining in an annotation image such as coordinate values of two diagonal points for a rectangle and coordinate values of successive points in drawing a line by a free hand.<sup>4</sup>

In rejecting Claim 8, the Official Action asserts that Ohkado teaches a global communication network including a video conferencing system. However, the cited portion of Ohkado only describes that the invention may be used in collaborating with another terminal located in a remote location. Ohkado does not disclose or suggest conducting a videoconference between said primary and secondary workstations, or displaying overlays between workstations during a videoconference. Ohkado does not disclose or suggest Applicants' claimed multiway conferencing unit (MCU).

MPEP § 2131 notes that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because Ohkado does not disclose or suggest all of the features recited in Claims 1, 25 and 27, Ohkado does not anticipate the invention recited in Claims 1, 25 and 27, and all claims depending therefrom.

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<sup>4</sup> Ohkado column 13, lines 1-17.

Accordingly, in view of the present amendment and in light of the previous discussion, Applicant respectfully submits that the present application is in condition for allowance and respectfully requests an early and favorable action to that effect.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Bradley D. Lytle  
Attorney of Record  
Registration No. 40,073

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413-2220  
(OSMMN 06/04)

Michael E. Monaco  
Registration No. 52,041

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